

IV. REMARKS

1. Claims 1, 2, 5, 6-9 and 11-14 are amended. Claims 15-21 are new.
2. The specification is amended to provide a description for reference numerals 42, 44 and 45 of FIG. 4.
3. Claims 1-2, 4, 6-7 and 9-14 as pending, are not unpatentable over Harrison et al. (6,064,420) ("Harrison") in view of Singkornrat et al (6,128,484) ("Singkornrat") under 35 U.S.C. §103(a).

In order to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), the combination of references must teach or suggest all of the claim limitations and there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings. There must also be a reasonable expectation of success. (See M.P.E.P. §2142). Harrison in view of Singkornrat does not disclose or suggest each feature of Applicants' invention as claimed.

Applicants' invention, as recited in claims 1, 13 and 14 states that the second information signal in a second format from the portable external device is transmitted to and received by the first input of the television device in the first format. There is no disclosure in Harrison of providing data received from the user interface device to the TV. Rather, quite to the contrary, the gist of Harrison lies in sending associated information from the set top box 35 to the user interface device 200 (Col. 13, lines 4-11).

Harrison, discloses a system for simulating a two-way connection by delivering associated data for local buffering and sub-sequent use with an external display and input (interface device 200). The associated data may be TV

broadcast among the primary data (TV program) for consumption at a consumer, where the associated data may be separated by a set top box 35 and wirelessly transmitted to a hand held data interface device 200 for consumption there, see column 13, lines 27 to 29 and 51 to 55. However, the interface device 200 itself displays the feedback to user input. Information may be exchanged between the user interface device 200 and the set-top box to retrieve (more) information. It is the user interface device 200, not the TV, that outputs any associated data. (See FIG. 9C, Col. 13, lines 25-37). Thus, unlike Applicants' invention as claimed, Harrison does not disclose or suggest providing data received from a user interface to a TV.

The combination of Singkornrat with Harrison does not overcome the above-noted deficiencies. Singkornrat discloses a system where a remote transceiver unit 16 may be connected to a PC 12 over a wireless connection to provide for remote operation of the PC 12 with a keyboard 18. The keyboard 18 connects to the PC 12 via the remote transceiver unit 16 and a base transceiver unit 14 connected to the PC 12. The remote transceiver unit transmits keyboard signals to the base transceiver unit 14 which subsequently provides them to the PC 12. (Col. 1, line 46 to Col. 2, line 50). Thus, a user may control the PC 12 with the keyboard 18. Singkornrat fails to disclose connecting a portable external device with a television device over a wireless connection so as to extend the user interface of the portable device. Instead, the portable device in Singkornrat is effectively connected to the PC 12 via the transceiver units 16 and 14.

This is not the same as what is recited by Applicants in the claims. Thus, Harrison in view of Singkornrat does not disclose or suggest each feature of Applicants' invention and a *prima facie* case of obviousness under 35 U.S.C. §103(a) cannot be established over claims 1, 2, 4, 6, 7 and 9-14.

Applicants also submit that there is no suggestion or motivation to modify the references as proposed by the Examiner. The Examiner's proposition that Applicants' invention would be obvious as recited in the claims is not supported by the factual contents of Harrison in view of Singkornrat. The references themselves and/or the knowledge generally available to one of skill in the art does not provide the requisite motivation or suggestion to modify the references as proposed for purposes of 35 U.S.C. §103(a). The disclosures of Harrison and Singkornrat are substantially incompatible. There is no obvious purpose or way to combine the teachings of two-way communications simulation where data is extracted from a TV broadcast for a handheld device 200 (Harrison) to an emulated laptop computer where a portable keyboard 26 controls a fixed PC 12 and the fixed PC connects to a TV (Singkornrat). Singkornrat aims at removing intelligence from the portable device to make use of an existing PC. Harrison instead targets providing a handheld processing device that can be used for providing a virtual two-way use experience with information associated to a TV broadcast. There is no suggestion or motivation in either reference that would lead one to combine the references. When "the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference". In re Rijckaert, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). The Examiner is requested to provide an indication as to where any such teaching, suggestion or motivation appears in the references. Absent such a teaching, it is submitted that a *prima facie* case of obviousness over Harrison in view of Singkornrat under 35 U.S.C. §103(a) is not established.

Furthermore, Applicants respectfully note that Harrison and Singkornrat have been combined improperly. References may be combined under 35 U.S.C. §103(a) only if the references are

analogous art. In this case Harrison and Singkornrat are not analogous art. A reference is analogous art if:

- 1) The reference is in the same field of endeavor as the applicant's, or
- 2) The reference is reasonably pertinent to the particular problem with which the applicant was concerned.

Neither Harrison nor Singkornrat are in the same field as the Applicants' invention.

Harrison is directed to providing a handheld processing device that can be used for providing a virtual two-way experience with information associated to a TV broadcast. Singkornrat is directed to removing intelligence from the portable device to make use of an existing PC. Applicants' invention, on the other hand, is directed to an adapter allowing an external device, such as a mobile station, to be connected to a television device so that the television device can be used as a display of the external device. Thus, Harrison and Singkornrat do not address the problems addressed by Applicants' invention. Since Harrison and Singkornrat are not in the same field of endeavor as the Applicants' endeavor and are not reasonably pertinent to the particular problem with which the Applicants were concerned, Harrison and Singkornrat are not analogous art. Therefore, Harrison may not properly be combined with Singkornrat for purposes of 35 U.S.C. §103(a).

Claims 2, 4, 6, 7 and 9-12 should be allowable at least in view of their dependencies.

4. Claims 3 and 5 are not unpatentable over Harrison in view of Singkornrat and further in view of Bodle (GB 2266637) under 35 U.S.C. §103(a).

Claims 3 and 5 depend from claim 1, which as noted above, is not unpatentable. Claims 3 and 5 should be allowable at least in view of the dependencies.


5. Claim 8 is not unpatentable over Harrison in view of Singkornrat and further in view of Hylton et al. ("Hylton") (5,708,961).

Claim 8 depends from claim 1 and should be allowable at least in view of the dependency.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

A check in the amount of \$128 is enclosed for an additional claim fee and one month extension of time. The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,


Geza C. Ziegler Jr.
Reg. No. 44,004

20 October 2003
Date

Perman & Green, LLP
425 Post Road
Fairfield, CT 06824
(203) 259-1800 Ext. 134
Customer No.: 2512



CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date indicated below as first class mail in an envelope addressed to the Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date: 10/20/03

Signature: D. Boland
Person Making Deposit

RECEIVED

OCT 28 2003

Technology Center 2600